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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Application of:
Berger, Jr., Allen

Date: **August 22, 2006**

Filing Date: **September 25, 2003**

Serial No. **10/669,900**

Attorney Dkt. No. **230199.3**

Title: **"SURFACE MOUNT WINDOW FOR DOORS"**

EXPRESS MAIL CERTIFICATE

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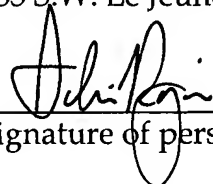
Date of Deposit: **August 22, 2006**

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Papers included:

- 1) Brief (Thrice) Amended for Appellant; and
- 2) postcard.

Adrian Rojas, Patent Dept.
235 S.W. Le Jeune Road, Miami, FL 33134



Signature of person mailing paper(s) or fee



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re: Application of:
Allen Berger, Jr.

Date: August 15, 2006

Serial No.: 10/669,900

Art Unit: 3635

Filed: September 25, 2003

Examiner: Robert J. Canfield

For: "SURFACE MOUNT WINDOW FOR DOORS"

Atty. Dkt. No. 230199.3

BRIEF (THRICE AMENDED) FOR APPELLANT

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Honorable Board Members:

This is an appeal from the Examiner of Art Unit 3635 finally rejecting claims 1 and 4 on appeal, and for which an amendment after final rejection was presented to the Examiner for the purposes of this appeal. The claims on appeal are included in the Appendix (page 8).

I. REAL PARTY IN INTEREST.

The Applicant, Allen Berger, Jr., is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES.

There are no other related appeals or interferences.

III. STATUS OF CLAIMS.

The following claims were filed with the continuation application
(with the preliminary amendment) for the SURFACE MOUNT WINDOW
FOR DOORS:

1. (Rejected). A window assembly for garage doors, comprising:

A) a transparent panel having an external surface and an
internal surface, said external surface including a peripheral flange
member making said external surface larger than said internal
surface with respective external and internal peripheral edges, and
said peripheral flange member further including a peripheral
underside surface that comes in abutting contact against the
peripheral external surface adjacent to an opening in a garage panel

with cooperative dimensions to permit said internal surface to go through; and

5 B) means for mounting said transparent panel on said garage panel.

2. (Canceled).

3. (Canceled).

10 4. (Rejected). The window assembly set forth in claim 1 wherein said means for mounting said transparent panel on said garage panel includes:

15 C) an external frame assembly mounted on said garage panel around said external peripheral edge.

This application is a continuation of application serial No. 10/244,482 filed on September 17, 2002. Initially, Applicant filed a preliminary
20 amendment leaving two claims in this patent application. Claim 1 is derived from the parent application and new claim 4. The amendment

filed on April 21, 2005, added the words "coplanarly extending" for clarification purposes. The amendment after final rejection (permitted by the examiner) replaced the word "go" with pass and added the words said opening also for clarification purposes. The two claims are rejected.

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IV. STATUS OF AMENDMENTS.

The Examiner entered the preliminary amendment filed on April 21, 2005 mentioned above and the amendment after final filed on August 5, 2005 has been entered at appeal. The two pending claims read as included in the appendix.

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V. SUMMARY OF THE CLAIMED SUBJECT MATTER.

15 The present invention relates to a novel surface mount window for doors, such as overhead garage doors. The invention allows a user to readily mount a window to a panel door that can withstand substantial wind loads. In figure 2 a garage door panel P with an opening shows how the transparent panel 20 partially passes through with peripheral flange 22 staying on one side of the panel P in contact with the latter with underside 24.

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The means for mounting the transparent panels is disclosed in page 4, lines 17-20 of the specifications including fastener members 80 that coact with frame assemblies 40 and 60, as best seen in figure 2.

5 **VI. GROUNDS FOR REJECTION TO BE REVIEWED
ON APPEAL**

Claims 1 and 4 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent 5,950,398 to Hubbard.

10 **VII. ARGUMENTS.**

References relied by the Examiner:

15	<u>Patentee</u>	<u>Patent No.</u>	<u>Publication Date</u>
	Hubbard	5,950,398	September 14, 1999

The Examiner has rejected claims 1 and 4 under 35 U.S.C. §102 (b) as being anticipated by Hubbard. Applicant respectfully disagrees.

20 **1. The cited reference fails to anticipate the claimed invention.**

The Examiner has rejected claims 1 and 4 under 35 U.S.C. 102(b), as being anticipated by U.S. patent No. 5,950,398 to Hubbard. Applicant respectfully disagrees. Hubbard shows inner pane or interior glazing 18 that the Examiner has equated to Applicant's internal surface. Inner pane 5 18, however, does not pass through the opening of sash 10. Rather, pane 18 is kept "within" the sash, on rabbet 12 abutting against "inner" face 14.

Also, the claimed invention includes peripheral flange members that come in abutting contact against the peripheral external surface adjacent to 10 opening. Hubbard's external surface 17 is also received within the opening, which is contrary to what is claimed herein. In sum, Hubbard teaches away from this invention.

The Examiner states: "If one considers the opening to be defined as 15 the space between reveal 16 and face 14..." p.2 of Advisory Action Before the Filing of an Appeal Brief. This assumption fails to take into consideration the explicit disclosure of the outer surface 13 of Hubbard's double glazed pass-by window unit 11. The real opening of the sash is defined by its outer surface 13. The rabbet 12 is interiorly defined and it is 20 inside the opening. Therefore, the Examiner's assumption is improper.

In claim 1 the peripheral flange comes in contact with the external surface. For Hubbard to anticipate Applicant's claimed invention, the outside panel 17 needs to have a peripheral flange that comes in abutting contact with outer surface 13 and this is not disclosed in Hubbard.

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Hubbard uses two panes 17 and 18. Applicant only utilizes one. Even if we were to combine pane 18 with pane 17, the combination does not pass through the opening of a garage door panel opening. Panel 18 is shown in figures No. 3 to be inside the sash.

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The Examiner's assumption is not inherent in the type of product described in Hubbard. Rabbets are used for recessing the panels in a sash. This is not intended in the present invention. In this regard, the CCPA has stated that "[I]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oerlich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981). Therefore, the Examiner's analogy is not saved by the limited application of inherency principle to overcome the burden of establishing anticipation.

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There is no evidence in the record that one with ordinary skill will equate the internal opening defined by a rabbet or reveal 14 with the true opening of a sash. Nor that causing a panel to come in abutting relationship with reveal 14 puts the claimed invention in the hand of one skilled in the art. *In re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

VIII. CLAIMS APPENDIX

1. A window assembly for garage doors, comprising:

5 A) a transparent panel having an external surface and an internal surface, said external surface including a coplanarly extending peripheral flange member making said external surface larger than said internal surface with respective external and internal peripheral edges, and said peripheral flange member further
10 including a peripheral underside surface that comes in abutting contact against the peripheral external surface adjacent to an opening in a garage panel with cooperative dimensions to permit said internal surface to pass through said opening; and

15 B) means for mounting said transparent panel on said garage panel.

4. The window assembly set forth in claim 1 wherein said means for mounting said transparent panel on said garage panel includes:

C) an external frame assembly mounted on said garage panel around said external peripheral edge.

IX. EVIDENCE APPENDIX.

5 No evidence was adduced in this application.

X. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

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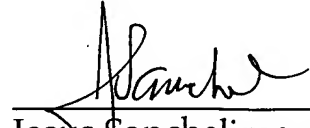
XI. CONCLUSION.

When this invention and the application's claims are fully analyzed and interpreted as explained above, it will be apparent that there is a good and clear difference between this invention and the cited prior art. When all factors are taken into consideration and given their due weight, it is believed that the Board of Appeals will be able to reverse the Examiner and such is now requested.

Kindly charge or credit our Deposit Account No: **19-0129** for the pertinent fees to cover the appeal brief fee.

Respectfully submitted,

SANCHELIMA & ASSOC., P.A.
Attorneys for Applicant
235 S.W. Le Jeune Road
Miami, Florida 33134-1762
Tel.: 305-447-1617
Fax: 305-445-8484

By: 
Jesus Sanchelima, Esq.
Reg. No. 28,755